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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,647	02/20/2004	George Mulcaire-Jones	50221-00002	7353
25231 7590 05/21/2008 MARSH, FISCHMANN & BREYFOGLE LLP 3151 SOUTH VAUGHN WAY SUITE 411 AURORA, CO 80014				
EXAMINER				
HOEKSTRA, JEFFREY GERDEN				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
05/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/783,647

**Applicant(s)**

MULCAIRE-JONES, GEORGE

**Examiner**

JEFFREY G. HOEKSTRA

**Art Unit**

3736

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/04/2008 has been entered.

### ***Notice of Amendment***

2. In response to the amendment filed on 04/04/2008, amended claim(s) 27 and canceled claim(s) 30 is/are acknowledged. The current rejections of the claim(s) 13-29 and 31 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 27-29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 27, and those depending therefrom, positively recites the limitation "the type of bead" in line 11. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 27, and those depending therefrom, positively recites the limitation "one of which is associated" in line 10. The scope of the claim, and those depending therefrom, is indeterminate with respect to which "one" of the plurality of beads types "is associated".

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 13-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Jennings et al (US 6,747,917 B2).

9. Jennings et al discloses a menstrual cycle monitoring apparatus (as best seen in Figures 1-2), comprising:

- a string (100);
- a plurality of beads (102,104,106,108,110,112) comprising at least ten bead types, wherein said plurality of beads are positioned and removed on/from said string (column 6 lines 52-57), wherein said plurality of beads comprising at least ten bead types includes up to 32 different bead type indicators having varying colors, shapes, sizes, and indicia (column 2 line 28 – column 3 line 21, and column 7 line 52-column 8 line 9), wherein any of the plurality of beads is capable of being oriented in at least three different orientations (for example forward facing on the string, backward facing on the string, forward facing on the string with band element 114, and backward facing on the string with band element 114), and wherein any of the plurality of beads is capable of being "associated with a fertile phase of the woman's

menstrual cycle one of which is associated with the day the woman's menses phase crosses over to a fertile phase of the woman's menstrual cycle, wherein the type of bead associated with the day the woman's menses phase crosses over to the fertile phase of the woman's menstrual cycle is capable of comprising a tri-color bead having three holes formed therethrough, wherein a first one of the holes is capable of including an opening in a first color portion of the tri-color bead, the first color portion is capable of being associated with a continued menstrual bleeding result of the observation, a second one of the holes is capable of including an opening in a second color portion of the tri-color bead, the second color portion is capable of being associated with a dry or absent cervical mucus result of the observation, and a third one of the holes is capable of including an opening in a third color portion of the tri-color bead, the third color portion is capable of being associated with a sticky or egg-white cervical mucus result of the observation"; and

- an ovulation prediction kit (column 1 line 39 – column 2 line 9) capable of providing results indicative of luteinizing hormone levels and associated with any one of the plurality of beads and/or bead types.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 27-29 and 31 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments with regards to the rejection of claims 13-26 filed 01/04/2008 and 04/16/2008 have been fully considered but they are not persuasive. Applicant argues the anticipatory rejection of the claims under Jennings, specifically

Applicant argues Jennings does not disclose, teach, and/or fairly suggest (a) the positively recited differently appearing types or number of beads as recited in independent claims 13 and 21, (b) the "ovulation prediction kit for determining the day during a fertile phase of the woman's menstrual cycle when a level of luteinizing hormone released by the woman's pituitary gland surges and a ninth type of bead positioned on the string to indicate the day when the luteinizing hormone level surges based on a result from the ovulation prediction kit and removed from the string at the end of the woman's menstrual cycle" of claim 21, or (c) the removable beads of claims 13 and 27.

12. With regards to Applicant's argument (a) that Jennings does not disclose the positively recited differently appearing types or number of beads as recited in independent claims 13 and 21 including up to nine types of beads that are different in appearance from one another in at least one of color, shape, or size, the Examiner reiterates that Jennings discloses "...beads ... may be consecutively numbered from one through thirty-two" (column 7 lines 52-55) and "...if the preferred shapes of beads are not locally available, other shapes can be used without departing from the present invention..." (column 8 lines 7). Thus Jennings discloses up to 32 differently appearing types of beads that are different in appearance from one another in both shape and color.

13. With regards to Applicant's argument (b) that Jennings does not disclose the "ovulation prediction kit for determining the day during a fertile phase of the woman's menstrual cycle when a level of luteinizing hormone released by the woman's pituitary

gland surges and a ninth type of bead positioned on the string to indicate the day when the luteinizing hormone level surges based on a result from the ovulation prediction kit and removed from the string at the end of the woman's menstrual cycle" of claim 21, the Examiner reiterates that as broadly as structurally claimed Jennings discloses "an ovulation prediction kit" (column 1 line 39 - column 2 line 9) that is capable of providing results indicative of luteinizing hormone levels and is capable of associated with any one of the plurality of beads and/or bead types. The Examiner notes the structure as disclosed by Jennings is capable of the positively recited functions and/or intended use of the "ovulation prediction kit" as broadly as structurally claimed.

14. With regards to Applicant's argument (c) that Jennings does not disclose the removable beads of claims 13 and 27, the Examiner notes Jennings discloses that the plurality of "...beads...are strung on a strong, durable, cord or wire that can be securely tied" such that as broadly as structurally claimed the beads are capable of the function and/or intended use of being removed from the string, cord, or wire (e.g. the string, cord, or wire is capable of being untied).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./  
Jeff Hoekstra  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736